



UNITED STATES PATENT AND TRADEMARK OFFICE

clh

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,226	07/03/2003	Albert M. Benzoni	XPNT19NP	7027
36394	7590	04/28/2005		
CHRISTIE, PARKER & HALE, LLP 350 W. COLORADO BLVD. SUITE 500 PASADENA, CA 91105			EXAMINER ULLAH, AKM E	
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,226

Applicant(s)

BENZONI ET AL.

Examiner

Akm Enayet Ullah

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8, 10-17 and 19-22 is/are rejected.
- 7) ☒ Claim(s) 4, 6, 7, 9 and 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Detailed Action

Applicant cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Status of the Application

Claims 1- 22 are pending in this application.

This application claims benefit of the US provisional patent applications of 60/393,973 filed on July 05, 2002, 60/466,799 filed on April 29, 2003 and 60/473,699 filed on May 27, 2003.

If applicant is aware of any prior art or any other co- pending application not already of record, he/she is reminded of his/her duty under 37 CFR 1.56 to disclose the same.

If applicant provides prior art, he/she is requested to cite it on form PTO-1449 in accordance with the guideline set forth in MPEP 609.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3,5, 8, 10-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al (USP NO. 5,737,467) in view of Bradley (USP NO. 5,123,070).

Kato et al disclose an optical assembly, comprising:

An optical device (123,130, 131)

A planar waveguide substrate (120)

A micro-hermetic cavity (128) for receiving the optical devices (130)

An optical fiber (140), which is coupled to the optical device.

The optical device comprises an optical waveguide formed in a surface of the substrate (column 12, lines 10-15).

The core (optical device) 123 of a silica waveguide coupler and cladding layer (124) are formed on the surface of the substrate (120) mentioned in column 10, lines 40-45.

The cavity (128) for receiving the optical devices 130, 131 and 123 and the lid 127 is sealingly secured to the substrate. (column 10, first paragraph).

Sealing means lid sealed around a perimeter of the micro hermetic cavity

Multiple transmission optical waveguides formed concurrently on a common substrate wafer mentioned in figure 6 and column 12 last two paragraphs.

Bradley (USPNO. 5,123,070) disclose an optical coupling assembly comprising an optical device (10) on a substrate (2) an external transfer optical waveguide (12) including an optical junction region) coupling area adjacent waveguide 20), a transmission optical waveguide (20) including an optical junction region) coupling area adjacent waveguide 12), the optical laser device and the external transfer optical waveguide being optically integrated for enabling transfer of optical power therebetween and with both external transfer optical waveguide and the transmission optical waveguide being

adapted for and positioned for enabling transverse-transfer of optical power therebetween at the respective optical junction regions.

Kato et al differ from the claimed invention because he does not explicitly disclose the optical power transfer between an interior volume of the micro-hermetic cavity and a volume exterior thereto as claimed throughout the claims.

Bradley (USPNO. 5,123,070) et al is the evidence that ordinary skill in the art would find a reason, suggestion or motivation to have such the optical power transfer between an interior volume of the micro-hermetic cavity and a volume exterior thereto. For detail see figures 1-5 and along with their respective portion of the specification.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the apparatus of Kato et al in view of Bradley reference since Kato et al's arrangement between the optical device and the fiber can be optimum, thereby reducing the connection loss.

Regarding method claims since the claims fail to mention any specific types of manufacturing steps (rather the generic and all corresponding steps of assembling) thus, the method claimed is also rejected for the same reasons as mentioned above by Kato et al in view of Bradley et al.

Objections to Claims, Allowable Subject Matter

Claims 4, 6-7, 9, 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Cited Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Blauvelt et al (US Pub. No. 2003/0081902), Sasaki et al (USPNO. 6,238,100), Crafts et al (US Pub.no. 2004/0161186), Allen et al (USP NO. 6,028,497), Crafts et al

(2003/0219192) and Bishop et al (6.400,009) are also cited show a typical optical device and a optical fiber defining a hermetic cavity and sealing the hermetic cavity along with a substrate respectively.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akm Enayet Ullah whose telephone number is 571-272-2361. The examiners can normally be reached on Monday through Wednesday from 5:30 am to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick, can be reached on Monday through Friday whose telephone number is 571-272-2344. The

fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more

information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Akm Enayet Ullah
Primary Examiner
Art Unit 2874

Aullah

April 26, 2005